

REMARKS

In the Advisory Action mailed September 8, 2003, the Examiner checked Box 2, indicating that the amendments proposed in Applicant's Amendment After Final Rejection dated August 11, 2003 will not be entered because they raise new issues that would require further consideration and/or search. The Examiner also checked Box 7, indicating that, for purposes of Appeal, the proposed amendments will be entered and an explanation of how the amended claims would be rejected would also be provided. The Examiner did not provide any such explanation either in the space allotted in section 7 or in an appended page. As a result, it is unclear to Applicant whether the amended claims have been entered, and, if they have been entered, why they would be rejected. Two phone messages requesting clarification regarding the status of the claims and the reasons for rejection were not returned before the deadline to respond Advisory Action. Accordingly, Applicant submits this Preliminary Amendment containing the same Amended Claims contained in the Amendment After Final Rejection dated August 11, 2003.

Claim 12 was rejected under Section 112, second paragraph, as being indefinite with regard to the limitation "the light-weight and high-strength beam member" in line 2. This language has been removed from the amended claim 12.

Claim 3 was rejected under Section 112, second paragraph, as reciting the limitation "the recessed end plate" in line 3. Claim 3 has no such language, however, and so this rejection is not understood. Applicant respectfully requests that a new Office Action be provided that clarifies this rejection so that a proper response may be formulated.

Claim 12 was rejected under Section 112, second paragraph, as being indefinite with regard to the recitation "having the same strength" and "having the same length". It is respectfully submitted that those skilled in the art will recognize that this language is another way of stating the recitation of a "full moment connection" for which there is antecedent basis in claim 1. Reconsideration and withdrawal of the Section 112 rejection of claim 12 is respectfully requested.

Claims 1, 4, 5, and 8-10 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over CH 000414118 in view of Berardi. Claims 1 and 8-9 have been

amended to recite the limitation that the flanges are C-shaped in transverse cross-section, adding that the inwardly extended leg sections further comprise in-turned free end portions and further that the protrusions of the web member are welded to these in-turned free end portions. This limitation is not taught or suggested by either CH 000414118 or Berardi. In CH 000414118 the web section is welded only to the web member W of the flanges 2 and not to the leg sections or to the in-turned free end portions of the flange leg sections. This added limitation further patentably distinguishes the present invention from the cited prior art. Reconsideration and withdrawal of the 103(a) rejection is respectfully requested.

Berardi does not teach end plates that give rise to the full moment connection available with the present invention. As described in co-owned U.S. Patent No. 4,964,256 of the same inventor, the technique used by Berardi of attaching the end plate by simply abutting it to the end face of the beam member and welding along the contact lines will not result in a high-strength connection that will permit the beam members to be connected end-to-end to form an extended length beam member of the same strength. Specific reference is made to Fig. 8 of the '256 patent which shows the prior art connection method which is functionally identical to that taught by Berardi. The application of Berardi to the present application should be withdrawn as inapposite.

Claims 1, 8, 9, 11, and 12 of the application have been amended to further distinguish the application over prior art and to more particularly point out and distinctly claim the subject matter that Applicant regards as the invention so as to place the application, as a whole, into a prima facie condition for allowance. Great care has been taken to avoid the introduction of new subject matter into the application as a result of the foregoing modifications.

The amendments made to the claims have been in response to suggestions made by the Examiner and also to put the application in better condition for appeal should the same be found necessary.

The purpose of the claimed invention is not taught nor suggested by the cited references, nor is there any suggestion or teaching which would lead one skilled in the relevant art to combine the references in a manner which would meet the purpose of the claimed invention. Because the cited references, whether considered alone, or in

combination with one another, do not teach nor suggest the purpose of the claimed invention, Applicant respectfully submits that the claimed invention, as amended, patentably distinguishes over the prior art, including the art cited merely of record. Based on the foregoing, Applicant respectfully submits that its claims 1, 11, and 12, as amended, are in condition for allowance at this time, patentably distinguishing over the cited prior art. Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Kent A. Herink, Applicants' Attorney at 515-288-2500 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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